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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,786	07/12/2001	Avi Ashkenazi	10466/84	3015

30313 7590 09/26/2002

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EXAMINER

ANDRES, JANET L

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 09/26/2002

(1)

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,786

Applicant(s)

ASHKENAZI ET AL.

Examiner

Janet L Andres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 39-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. According to the priority statement of 20 August 2002, the claimed subject matter defined in the instant application is supported by parent application serial nos. 60/065186, 60/066770, 60/088026, PCT US98/19437, PCT US00/044144, and 09/665350. Based on the information given by applicant and an inspection of the patent applications, the examiner has concluded that the subject matter defined in this application is supported by the disclosure in application serial no. PCT US98/19437, filed 17 September 1998 but is not supported by any of the earlier applications because no utility for the claimed polypeptide, PRO 335, is disclosed in the earlier provisional applications. The results of the MLR assays are first reported in PCT US98/19437. Accordingly, the subject matter defined in claims 39-58 has an effective filing date of 17 September 1998.

Should the Applicant disagree with the examiner's factual determination above, it is incumbent upon the applicant to provide the serial number and specific page number(s) of any parent application filed prior to 17 September 1998 that specifically supports the particular claim limitation for each and every claim limitation in all the pending claims which applicant considers to have been in possession of and fully enabled prior to 17 September 1998.

Specification

2. The disclosure is objected to because of the following informalities: There are sequences on pages 2, 14, and 16 that lack sequence identifiers. MPEP §2421.02 states that the sequence rules embrace all unbranched nucleotide sequences with ten or more bases and all unbranched,

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non-D amino acid sequences with four or more amino acids, provided that there are at least 4 "specifically defined" nucleotides or amino acids.

The disclosure is further objected to because the address of the American Type Culture Collection on p. 250 is incorrect. It is now located in Manassas, VA.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 39-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 39, and by dependency claims 40-43 are drawn to antibodies that bind to the polypeptide of SEQ ID NO: 290, while claim 44 is drawn to an antibody that "specifically binds" to this polypeptide. "Specific binding" is not defined in the specification; one of skill in the art would not know what the metes and bounds of "specific" were intended to be and would not know what level of binding, and thus what antibodies, were included in the limitations of the claims. One of skill in the art would further not be able to differentiate "binding" as in claims 39-43 from "specific binding" as in claim 44 and would not be able to determine which molecules were encompassed by the different claims.

NO CLAIM IS ALLOWED.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

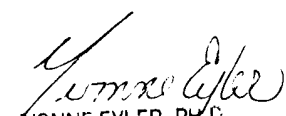
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 872-9306 or (703) 872-9307 for after final communications.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to yvonne.eyler@uspto.gov.

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.
September 25, 2002


YVONNE EYLER, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600